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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Mari Kodama

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EXAMINER

PARK, CHAN S

ART UNIT

PAPER NUMBER

2625

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02/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/804,062	Applicant(s) KODAMA ET AL.	
	Examiner CHAN S. PARK	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-10, 12-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10, 12-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/29/09 has been entered.

Response to Amendment

2. Applicant's amendment was received on 1/29/09, and has been entered and made of record. Currently, **claims 1-3, 5-10, 12-17 and 19-21** are pending.

Response to Arguments

3. Applicant's arguments with respect to **claims 1-3, 5-10, 12-17 and 19-21** have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

4. Claims are objected to because of the following informalities:

Claim 1, line 1, "the incompatibility detecting" should be -- the incompatibility detection --; and

Claim 1, line 16, "entire image date" should be -- entire image data --.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 8-10 and 12-14** are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor is positively tied to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. For example the image processing method including steps

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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of performing, executing, charging and storing is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. The Applicant has provided no explicit and deliberate definitions of “performing”, “executing”, “charging” or “storing” to limit the steps to process by a particular apparatus and the claim language itself is sufficiently broad to read on a person being shown a printout of an image, mentally detecting the incompatible part, charging the detection processing, and mentally repeating the incompatibility detection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claims 1, 8 and 15** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the limitation of “the incompatibility detection processing including image processing”. Upon careful review of the original Specification (corresponding U.S. Patent Application Pub. No. 2004/0199864), it is concluded that the incompatibility detection processing does not include any image processing. For example, paragraph [0282] states “it is necessary to

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detect the revision not by page but by paper, and perform a second-time RIP process upon the detected sheet of paper" and paragraph [0314] states "the image processing program 22 detects a revised portion added to the drawing data, and makes a request to the image processing server 3 (RIP/color correction program 34; FIG. 22) for a re-RIP process and the like." The Specification appears to indicate that the incompatibility detection processing is a separate and independent from the image processing. Clarification/explanation from the Specification is requested.

Furthermore, the claims recite a limitation of "an accounting unit that charges for the executed incompatibility detection processing". However, upon careful review of the Specification, the account unit appears to charge for the image processing executed on the detected incompatibility part, not for the executed incompatibility detection processing itself (emphasis added). Is the fee applied for simply detecting the incompatibilities? Or is it charged for the image processing performed on the detected incompatibilities? Clarification/explanation from the Specification is requested.

The examiner specifically requested to explain if there are any charges applied for the incompatibility detection processing itself (please refer to page 2-3 of the Final rejection dated 10/29/08 & the interview summary dated 1/27/09). However, no explanation is provided to overcome the rejections.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1, 8 and 15** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite the limitation of “the incompatibility detection processing including image processing”. It is unclear as to what kind of image processing is necessary to perform the incompatibility detection processing. One of ordinary skill in the art would recognize that a mere image detection processing is not an image processing since no image processing is done by a simple image detection.

Furthermore, claims recite the limitation of storing “the result of the incompatibility detection processing in a separate location from the image data” in lines 18-19. There is insufficient antecedent basis for this limitation in the claim. It is unclear if this incompatibility detection processing is referring to the detection processing recited in lines 4-5 or the repeated detection processing recited in lines 12-13. Moreover, it appears that the result of the incompatibility is stored every time the incompatibility detection is performed (lines 18-19). If so, does the incompatibility part detection unit ever stop performing the detection since there are always the results stored in the storing unit? Clarification/explanation from the Specification is requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 5-10, 12-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishide et al. U.S. Patent Application Pub. No. 2003/0007173 (hereinafter Nishide) in view of Kawamoto U.S. Patent Application Pub. No. 2003/0140008.

With respect to claim 1, Nishide discloses an image processing apparatus (print server 12 in paragraph 79) comprising:

an image processing unit that performs a first image processing on image data including one or more image constituent parts (performing image processing on the print job having RGB images according to paragraphs 85 & fig. 5);

an incompatible part detection unit that executes an incompatibility detection processing to detect an incompatible part of the image data, the incompatible part being incompatible with the first image processing (detecting the image in RGB format in fig. 5 & note that the RGB image is in compatible with the printer according to paragraph 61); and

a detection result storing unit that stores at least a result of the incompatibility detection processing, wherein

the incompatible part detection unit performs the incompatibility detecting processing again only on the detected incompatible part under the condition that the result of the incompatibility detection processing has been stored;

the incompatible part detection unit performs the incompatibility detection processing again on the entire image data under the condition that no result of the incompatibility detection processing is stored (detecting the image in RGB format in fig. 5 & note that the RGB image is incompatible with the printer according to paragraph 61); and

the detection result storing unit stores the result of the incompatibility detection processing in a separate location from the image data (it is inherent to include a storage for storing the result message (fig. 5) for display).

Nishide, however, does not explicitly disclose an accounting unit that charges for the executed incompatibility detection processing. (For examining purpose, the limitation is construed as charging for the image processing executed for the incompatibility parts.)

Kawamoto discloses a printing system comprising an accounting unit that charges for the image processing executed on the image data for printing (paragraph 71 & fig. 10).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Nishide to incorporate the accounting unit as taught by Kawamoto.

The suggestion/motivation for doing so would have been to accurately calculate the charges based on the print job processed.

Therefore, it would have been obvious to combine Nishide with Kawamoto to obtain the invention as specified in claim 1.

With respect to claim 2, Nishide discloses the image processing apparatus according to claim 1,

wherein the first image processing is a print job for printing the image data (performing image processing on the print job having RGB images according to paragraph 85 & fig. 5); and

the incompatible part detection unit detects, as the incompatible part, an image constituent part on which the print job cannot be performed normally, from the image constituent parts of the image data (detecting the image in RGB format in fig. 5 & note that the RGB image is incompatible with the printer according to paragraph 61).

With respect to claim 3, Nishide discloses the image processing apparatus according to claim 2,

wherein the incompatible part includes at least:

a first image constituent part having a color format other than a color format that can be reproduced by the print job (image having the RGB format in fig. 5 & note that the RGB image is incompatible with the printer according to paragraph 61).

With respect to claim 5, Nishide discloses the image processing apparatus according to claim 1, further comprising:

a detection display unit that displays a detection of the incompatible part when the incompatible part is detected (fig. 7).

With respect to claim 6, Nishide discloses the image processing apparatus according to claim 5, wherein

the image processing unit further performs a second image processing;

when an instruction to execute the second image processing on the image constituent parts on which the incompatibility detection processing has been performed is given in response to the displaying of the incompatible part, the second image processing is executed on the incompatible part; and

the incompatible part subjected to the second image processing is combined with image constituent parts other than the incompatible part subjected to the second image processing (paragraphs 63-66).

With respect to claim 7, the combination discloses the image processing apparatus according to claim 6, wherein the accounting unit further charges for the executed second image processing (paragraph 46 of Kimura).

With respect to claims 8-10 and 12-14, arguments analogous to those presented for claims 1-3 and 5-7, are applicable.

With respect to claims 15-17 and 19-21, arguments analogous to those presented for claims 1-3 and 5-7, are applicable.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Examiner, Art Unit 2625

February 24, 2009